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Applicant: Constantino et al.

Examiner: Stone, Jonathan D.

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For: **CONTRACT HANDLING METHOD AND SYSTEM**

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REPLY BRIEF OF APPELLANTS

This Reply Appeal addresses issues raised in the Examiner's Answer mailed March 9, 2004.

Issue 1

CLAIMS 1, 3, 6-7, 9, 12-13, 15, 18, 19, and 21 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(a) OVER LUCHS (USPN 4831526) IN VIEW OF HOYT (USPN 6067531) AND IN FURTHER VIEW OF SHIRLEY (USPN 5692206).

The Examiner rejected claims 1, 3, 6-7, 9, 12-13, 15, 18, 19, and 21 under 35 U.S.C. §103(a) as allegedly being unpatentable over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.* (USPN 6067531) and in further view of Shirley *et al.* (USPN 5692206).

Claims 1, 7, and 13

The Examiner's Answer responded to five examples in Appellants' Brief as to why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt *et al.* and in further view of Shirley.

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First Example (Claims 1, 7, and 13)

As argued by Appellants' Brief, the first example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley is that Luchs in view of Hoyt and in further view of Shirley does not teach or suggest "one or more model agreements" in combination with "a document assembler for selecting and merging all or part of said one or more model agreements into a contract" (claim 1); "assembling and merging all or part of said one or more model agreements into a contract" (claim 7); and "third program instruction means for assembling and merging all or part of said one or more model agreements into a contract" (claim 13).

The Examiner's Answer argues: "As per the first example, Applicant argues that "Luchs' system does not include model agreements (i.e., model contracts) as required by claims 1, 7 and 13, but instead includes a database of stored paragraphs, such that an insurance agreement(i.e., insurance contract) may be formed from the selection of particular paragraphs from the database of paragraphs." Examiner disagrees with this characterization. Referring to the actually claimed limitation, in Claim 1, line 4, "selecting and merging all or part of said one or more model agreements into a contract in response to said client requests." Compare that limitation with Luchs in col. 4, line 17, "separate and complete paragraphs are sequenced ... to yield an insurance contract." Firstly, it must be noted that the "model agreement" is not "model contracts" as Appellant argues. Rather, the claim states that the model agreements are merged into a contract. This is exactly what is shown by Luchs as explained in col.4, line 17."

In response to the Examiner's Answer, Appellants contend that Luchs' system does not include model agreements (i.e., model contracts) as required by claims 1, 7, and 13, but instead

includes a database of stored paragraphs, such that an insurance agreement (i.e., insurance contract) may be formed from the selection of particular paragraphs from the database of paragraphs. The Examiner has offered no support for the Examiner's contention that Luch's stored paragraphs are model agreements, as required by claims 1, 7, and 13. To illustrate, an agreement contains particularized content; i.e., an agreement is "an understanding or arrangement between two or more people, countries, etc." Webster's New World Dictionary, 26 (3d ed. 1988). Similarly, an agreement is "a manifestation of mutual assent on the part of two or more persons as to the substance of a contract." Black's Law Dictionary 67 (6th ed. 1990).

In contrast, Luchs does not limit the content of the stored paragraph to the content of a model agreement. For example, the stored paragraph may constitute the signature block of the contract, which is not a model agreement. As another example, the stored paragraph may constitute the initial paragraph of the contract identifying the parties, which is likewise not a model agreement.

In summary, the agreements in claims 1, 7, and 13 are subject to a limitation consistent with the meaning of the phrases "agreement" and "model agreement," whereas the content of a stored paragraph in Luchs is limited only to being a paragraph of a contract. In essence, the Examiner has not provided any evidence demonstrating that the paragraphs in Luchs are model agreements as required by claims 1, 7, and 13.

Second Example (Claims 1, 7, and 13)

As argued by Appellants' Brief, the second example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley is that Luchs in view of Hoyt and in further view of Shirley does not teach or suggest: "a document assembler for

selecting and merging all or part of said one or more model agreements into a contract in response to said client request” (claim 1); “assembling and merging all or part of said one or more model agreements into a contract in response to said client request in said entry tool” (claim 7); and “third program instruction means for assembling and merging all or part of said one or more model agreements into a contract in response to said client request in said entry tool” (claim 13).

The Examiner’s Answer incorrectly characterized Appellants’ argument as relating to the distinction between one agreement and more than one agreement. Rather, Appellants’ Brief stated that: “Appellants reiterate that an individual paragraph is not a model agreement, as explained *supra* in conjunction with the First Example.” In other word, Luchs does not teach or suggest assembling and merging all or part of one or more model agreements into a contract, because Luchs teaches the merging of stored paragraphs and does not teach or suggest the merging of model agreements.

Third Example (Claims 1, 7, and 13)

As argued by Appellants’ Brief, the third example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley is that Luchs in view of Hoyt and in further view of Shirley does not teach or suggest “a repository for storing said contract and said tracking data and for responding to said client inquiry” (claim 1); “storing said contract and said tracking data in a repository” (claim 7); and “fifth program instruction means for storing said contract and said tracking data in a repository” (claim 13).

The Examiner’s Answer argues: “As per the third example, Appellant argues that “it is

not obvious to modify Luchs to include a repository in which to store the tracking information associated with the contract, because Luchs is concerned only with processing insurance application and generating insurance contracts therefrom. Luchs is not concerned with tracking information associated with the generated insurance contract. In response to applicant's argument that Luchs is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hoyt teaches the capability for "tracking" any contracts and Luchs teaches creating "insurance contracts." It is clear that a person of ordinary skill in the art would have appreciated the benefit of Hoyt in processing any types of contracts to the processing of the specific type of contract in Luchs".

In response to the Examiner's Answer, Appellants have not argued that Luchs is nonanalogous art with respect to Hoyt, as the Examiner alleges. Rather, Appellants' Brief argued that "it is not obvious to modify Luchs to include a repository in which to store the tracking information associated with the contract, because Luchs is concerned only with processing insurance applications and generating insurance contracts therefrom. Luchs is not concerned with tracking information associated with the generated insurance contracts. Therefore, modifying Luchs as suggested by the Examiner is not relevant to the purpose of Luchs' invention and is thus not obvious." Appellants contend that the Examiner's statement that "It is clear that a person of ordinary skill in the art would have appreciated the benefit of Hoyt in processing any types of contracts to the processing of the specific type of contract in Luchs" is vague and does

not persuasively explain why a person of ordinary skill in the art would modify Luchs to include a repository in which to store the tracking information associated with the contract.

Fourth Example (Claims 1, 7, and 13)

As argued by Appellants' Brief, the fourth example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley is that the Examiner's argument for modifying Luch's invention with Hoyt (for approvals) and Shirley (for key date reminders) is not persuasive.

The Examiner's Answer argues: "In reference to the fourth example, Applicant argues that "[i]mportantly, the reinstatement mechanism disclosed in Luchs, col.2, lines 43-46 is simple and apparently works without the need to add the unnecessary complexity of Shirley's tracking date." In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Luchs system may be "simple" but teaches what is claimed and the rationale for the combination with the Hoyt and Shirley has been sufficiently provided."

In response to the Examiner's Answer, Appellants have not attempted to show nonobviousness by attacking references individually where the rejections are based on combinations of references, as alleged by the Examiner. Rather, Appellants' Brief argues that "Appellants observe the following teaching in col. 2, lines 14-18 of Shirley: "The present invention also provides auxiliary documents which are related to the negotiated contract

documents such as payment schedules, due date schedules, termination dates, and other tasks which accompany the execution of a contract ". A review of the preceding dates disclosed in Shirley reveals that said dates disclosed in Shirley relate essentially to events which will occur after the contract has been generated and not to events that support the contract generation process. However, Luch's invention is concerned essentially with the contract generating process and not with events occurring after the contract has been generated. Therefore, Shirley's dates are not relevant to Luch's invention. Accordingly, it would not be obvious to a person of ordinary skill in the art to modify Luch's invention by adding Shirley's means for tracking dates." Appellants contend that the Examiner's Answer did not address the preceding argument of Appellants.

In addition, Appellants' Brief argued: "Luchs, col. 2, lines 43-46 does not teach "displaying an application (i.e. contract) for the purpose of approval/disapproval " as alleged by the Examiner. Rather, Luchs, col. 2, lines 43-46 teaches a reinstatement file to facilitate entry of a reinstatement order. Importantly, the reinstatement mechanism disclosed in Luchs, col. 2, lines 43-46 is simple and apparently works without the need to add the unnecessary complexity of Shirley's tracking dates. Thus it is not obvious to modify Luchs with Shirley's tracking dates." Appellants contend that the Examiner's Answer did not persuasively respond to the preceding argument of Appellants.

Fifth Example (Claims 1, 7, and 13)

As argued by Appellants' Brief, the fifth example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley is that Luchs in view of

Hoyt and in further view of Shirley does not teach or suggest: “a tracker tool coupled to said entry tool and said document assembler for processing key date reminders and approvals into tracking data” (claim 1); “processing key date reminders and approvals into tracking data” (claim 7); and “fourth program instruction means for processing key date reminders and approvals into tracking data” (claim 13).

Appellants’ Brief stated that while the Examiner has made arguments relating to the storing of tracking data and the tracking of dates, the Examiner has made not made any argument relating to processing key date reminders and approvals into tracking data, as required by claims 1, 7, and 13.

The Examiner’s Answer argues: “As per the fifth example, Appellant argues that "While the Examiner has made arguments relating to the storing of tracking data and the tracking dates, the Examiner has made not made any argument relating to processing key date reminders and approvals into tracking data." Examiner points to the fact that the claims define the invention, and the claim calls for "processing ...,into tracking data." Thus, "storing the data... along with the tracking data" is a form of "processing." ”

In response to the Examiner’s Answer, Appellants contend that the Examiner’s argument related to “processing” does not negate the fact that the Examiner has not made any argument demonstrating that Luchs in view of Hoyt and in further view of Shirley teaches or suggests “processing key date reminders and approvals into tracking data”, as required by claims 1, 7, and 13. Thus, the Examiner has established a *prima facie* case of obviousness in relation to claims 1, 7, and 13.

Claim 13: Additional Argument

As argued by Appellants' Brief with respect to claim 13, the Examiner argued in the office action rejection that: "[t]he use of a computer readable medium on which to store program instructions, program products, and other data was known and typical at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a computer readable medium in the invention described in the rejection of claim 1. This would have provided the invention with local access to program instructions to implement the invention as well as access to databases and storage areas."

Appellants' Brief explained that the preceding argument by the Examiner is not persuasive because the Examiner's argument is generic and non-specific. In particular, the Examiner has not offered any argument that relates specifically to Luchs' invention. If the Examiner is permitted to offer a generic, non-specific argument without any consideration of the specifics of Luchs' invention, then the Examiner would be able to use such an argument with respect to *any invention* for which it is theoretically possible to use a computer readable medium, processor, computer storage, databases, etc. Accordingly, Appellants respectfully maintain that the Examiner has not satisfied the Examiner's burden of proof to establish a *prima facie* case of obviousness in relation to claim 13.

The Examiner's Answer argues: "With respect to Claim 13 on page 13 of the Brief, Appellant argues that the Examiner's rejection is "generic and non-specific". The rejection states that claim 13 is for a computer readable medium comprising the method of claim 1, and thus, the use of the computer readable medium would have been obvious to a person of ordinary skill in the art at the time of the invention. Examiner cannot understand why the argument is "generic

and non-specific." Clearly, Luchs, Hoyt and Shirley disclose the computer implemented methods. Since the instructions (e.g., software) must reside in a computer readable medium in order to be executed by the computers, any computer implemented methods being stored in a computer readable medium would be inherently or at least would have been obvious to a person of ordinary skill in the art at the time of the invention."

Appellants contend that the Examiner's Answer does not negate the fact that the Examiner's argument in the office action rejection for rejecting claim 13 was generic and was not applied specifically to any aspect of the inventions of Luchs, Hoyt, and Shirley. Therefore, Appellants contend that the Examiner has not satisfied the Examiner's burden of proof to establish a *prima facie* case of obviousness in relation to claim 13.

Claims 3, 9, and 15

As argued by Appellants' Brief, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest: "wherein said tracker tool is adapted to automatically send said key date reminders to said client via e-mail" (claim 3); "further comprising automatically sending said key date reminders to said client via e-mail" (claim 9); and "wherein said fourth program instruction means is adapted to automatically send said key date reminders to said client via e-mail" (claim 15).

Appellants' Brief argued that "Luchs is concerned with the efficient generation of an insurance policy, but is not concerned with sending key date reminders to insurance clients. Thus, the Examiner's reason for modifying Luchs with Hoyt is not relevant to the purpose of Luchs' invention." Appellants contend that the Examiner's Answer did not address the

preceding argument of Appellants.

In addition, Appellants' Brief argued that the Examiner's argument with respect to Shirley is an improper modification of the secondary reference of Hoyt. In particular, Appellants' Brief argued: "The Examiner argues that the primary reference of Luchs discloses a an insurance contract generation system. The Examiner also argues that the secondary reference of Hoyt has modified the primary reference of Luchs, by alleging that Hoyt teaches or suggests distributing documents to users after the status of the document is changed. The Examiner additionally argues that the secondary reference of Shirley has modified the secondary reference of Hoyt, by alleging that Shirley teaches or suggests using e-mail for distributing said documents (having changed status) to users. Appellants maintain that it is improper to argue that a claim feature is taught or suggested by a secondary reference through modification of another secondary reference. If the Examiner could modify a secondary reference in the preceding manner, then the Examiner would be able to show the existence of any element or feature of any claim merely by chaining a sufficient number of secondary references together in the preceding manner. Accordingly, Appellants respectfully maintain that the rejection of claims 3, 9, and 15 under 35 U.S.C. §103(a) is improper and should be withdrawn."

With respect to the preceding issue of modification of a secondary by another secondary reference, the Examiner's Answer argues: "Appellant argues that "it is improper to argue that a feature is taught or suggested by a secondary reference through modification of another secondary reference. If the Examiner could modify a secondary reference in the preceding manner, then the Examiner would be able to show the existence of any element or feature of any claim merely by chaining a sufficient number of secondary references together..." The argument

is not persuasive. There is not requirement limiting how many references can be used, or how they must, be combined. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).”

Appellants contend that the Examiner’s Answer has incorrectly portrayed Appellant as arguing that the Examiner has cited too many references. Appellants have not argued that the Examiner has cited too many references. Rather, Appellants have argued that the Examiner has improperly used the secondary reference of Shirley to modify the secondary reference of Hoyt. Appellants contend that an argument that depends on using a secondary reference to modify another secondary reference is a very weak argument and is therefore not persuasive.

Claims 6, 12, and 18

As argued by Appellants’ Brief, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest: “further comprising a library of supplemental provisions, accessible by said document assembler” (claim 6); “further comprising selecting a supplemental provision from a library of supplemental provisions and merging said supplemental provision into said contract” (claim 12); and “further comprising program instruction means for selecting a supplemental provision from a library of supplemental provisions and merging said supplemental provision into said contract” (claim 18).

Appellants’ Brief argued that: “Shirley’s “supplemental provisions” are essentially the same as Luchs’ paragraphs. Therefore, there is no need to modify Luchs by Shirley to add

supplemental provisions which Luchs already discloses as paragraphs. In other words, Shirley's supplemental provisions adds nothing to Luchs' invention."

The Examiner's Answer argued that "with respect to claims 6, 12 and 18, Appellant asserts that "Shirley's `supplemental provisions' are essential the same as Luchs' paragraphs. Therefore there is not need to modify Luchs by Shirley to add supplemental provisions." The argument is not persuasive. Shirley would have given an additional tailoring capability which is clearly a motivation."

In response, Appellants contend that the Examiner alleges that "Shirley would have given an additional tailoring capability". However, the Examiner provides no explanation as to how Shirley would have given an additional tailoring capability, since Luchs already has all of the insurance provisions that Luchs needs in Luchs' stored paragraphs. Therefore, the aforementioned argument in the Examiner's Answer is not persuasive.

Claims 19 and 21

As argued by Appellants' Brief, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest: "wherein said library of model agreements is recorded on said medium" (claim 19); and "wherein said library of supplemental provisions is recorded on said medium" (claim 21).

As argued by Appellants' Brief with respect to claims 19 and 21, the Examiner argued in the office action rejection that: "Regarding dependent claims 19 and 21, Luchs, Hoyt, and Shirley do not explicitly disclose recording a library of model agreements or supplemental provisions on a computer readable medium. However, it was known and typical at the time of the art to store

libraries on a computer readable medium accessible to an application associated with said libraries. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the library on a computer readable medium accessible to the current invention. This would have provided a user with easy access to the libraries.”

Appellants’ Brief explained that the preceding argument by the Examiner is not persuasive because the Examiner’s argument is generic and non-specific. In particular, the Examiner has not offered any argument that relates specifically to Luchs’ invention. If the Examiner is permitted to offer a generic, non-specific argument without any consideration of the specifics of Luchs’ invention, then the Examiner would be able to use such an argument with respect to *any invention* for which it is theoretically possible to use a computer readable medium. Accordingly, Appellants respectfully maintain that the Examiner has not satisfied the Examiner’s burden of proof to establish a *prima facie* case of obviousness in relation to claims 19 and 21.

The Examiner’s Answer for claims 19 and 21 relies on the Examiner’s argument with respect to claim 13.

In response, Appellants contend that the Examiner’s Answer does not negate the fact that the office action rejection argument for rejecting claims 19 and 21 was generic and was not applied specifically to any aspect of the inventions of Luchs, Hoyt, and Shirley. Therefore, Appellants contend that the Examiner has not satisfied the Examiner’s burden of proof to establish a *prima facie* case of obviousness in relation to claims 19 and 21.

Issue 2

CLAIMS 2, 8, and 14 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(a) OVER LUCHS (USPN 4831526) IN VIEW OF HOYT (USPN 6067531) AND SHIRLEY (USPN 5692206) AND IN FURTHER VIEW OF “FREQUENTLY ASKED QUESTIONS ABOUT YOUR VIRTUAL AGENT NETWORK FOR WORLD WIDE BUSINESS”.

The Examiner rejected claims 2, 8, and 14 under 35 U.S.C. §103(a) as allegedly being unpatentable over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.* (USPN 6067531) and Shirley *et al.* (USPN 5692206) and in further view of “Frequently Asked Questions about Your Virtual Agent Network for World Wide Business” (herein VAN; Australian American Chamber of Commerce, 1996).

As argued by Appellants’ Brief, Luchs in view of Hoyt and Shirley in further view of VAN do not teach or suggest “wherein said model agreements are in a plurality of languages”.

In the office action rejection, the Examiner alleged that “Luchs does not explicitly disclose model agreements in a plurality of languages. However, VAN teaches an invention for assisting users in buying and selling goods and negotiating the exchange of said goods. VAN discloses the use of the invention in multiple languages to cater to a global market (pg 1-2 and 16-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions disclosed by Luchs and VAN. Such a combination would have opened the use of Luchs' contract builder to a global market, instantly increasing the breadth of the invention.”

Appellants’ Brief responded to the preceding argument by the Examiner as follows: “VAN does not disclose model agreements in a plurality of languages as required by claims 2, 8, and 14. Instead, VAN discloses (on page 17 , lines 1-5) having software in a plurality of languages for negotiation purposes and not for contract generation purposes. Therefore, the

feature of "wherein said model agreements are in a plurality of languages" is not disclosed by either Luchs or VAN."

The Examiner's Answer addressed this issue by stating: "The prior art of VAN is only used to show that implementing in a plurality of languages for creating a legal communication system was well known." In response, Appellants contend that it is quite a stretch to allege that having software in a plurality of languages for negotiation purposes makes it obvious to have an insurance contract in a plurality of languages. Indeed, the Examiner has not provided any evidence in Luchs that would motivate one of ordinary skill in the art to have Luch's insurance contract in a plurality of languages.

As stated in Appellants' Brief and not effectively rebutted by the Examiner, the Examiner's argument for combining VAN with Luchs is no more than hindsight reconstruction.

Issue 3

CLAIMS 26 AND 29-35 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(a) OVER LUCHS (USPN 4831526) IN VIEW OF HOYT (USPN 6067531) AND SHIRLEY (USPN 5692206) AND IN FURTHER VIEW OF GRUBB (USPN 5272623).

The Examiner rejected claims 4-5, 10-11, 16-17, and 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.* (USPN 6067531) and Shirley *et al.* (USPN 5692206) and in further view of Grubb *et al.* (USPN 5272623).

Claims 4, 10, and 16

As argued by Appellants' Brief, Luchs in view of Hoyt and Shirley in further view of

Grubb do not teach or suggest: “further comprising a library of alternate clauses, accessible by said document assembler” (claim 4); “further comprising selecting one or more alternate clauses from a library of alternate clauses and replacing part of said selected one or more model agreements with said one or more alternate clauses” (claim 10); and “further comprising sixth program instruction means for selecting one or more alternate clauses from a library of alternate clauses and replacing part of said selected one or more model agreements with said one or more alternate clauses” (claim 16).

Appellants’ Brief argued that “Grubb’s “alternate clauses” are essentially the same as Luchs’ paragraphs. Therefore, there is no need to modify Luchs by Grubb to add alternate clauses which Luchs already discloses as paragraphs. In other words, Grubb’s alternate clauses adds nothing to Luchs’ invention.”

The Examiner’s Answer states: “with respect to claims 4, 10 and 16, Appellant argues that “Grubb’s ‘alternate clauses’ are essentially the same as Luchs’ paragraphs.” As explained with respect to claims 6, 12 and 18 above, the argument is not persuasive. Appellant may think that the Grubb’s system is “essentially the same” but Examiner disagrees with the subjective opinion.”

In response to the preceding argument in the Examiner’s Answer, Appellants contend that the idea of having alternate clauses from which to form a contract is already disclosed in Luchs. Luchs’ paragraphs could be reasonably characterized as clauses of an insurance contract and since these clauses (i.e., paragraphs) are selectively merged into an insurance contract, it follows that Luch’s paragraphs are themselves alternate clauses. Therefore, there is no need to combine Grubb with Luchs as the Examiner argues. Therefore, Appellants contend that the Examiner’s argument for rejecting claims 4, 10, and 16 is not persuasive.

Claims 5, 11, and 17

As argued by Appellants' Brief, Luchs in view of Hoyt and Shirley in further view of Grubb does not teach or suggest: "wherein said library of alternate clauses is indexed by type of clause" (claim 5); "wherein said one or more alternate clauses are selected from a library of alternate clauses indexed by type of clause" (claim 11); and "wherein said one or more alternate clauses are selected from a library of alternate clauses indexed by type of clause" (claim 17).

The Examiner's Answer argues that "Appellant argues that "Examiner has not cited a prior reference that teaches or suggests indexing the alternate clause by type of clause. [and thus] has not.. establish a prima facie case of obviousness." Examiner disagrees. Examiner pointed out that the feature was "well known in the art at the time of the invention." Appellant throughout the prosecution did not object the assertion that it was well known. If the assertion were made, Examiner would have provided a hard reference. Even now, Appellant is not objecting that it was well known. Rather, Appellant points out that there was no reference used. There is no requirement that a reference must used as long as it is agreed that certain features are well known."

In response, Appellants contend that Appellants' argument that the Examiner has not supplied a supporting reference is a challenge to the Examiner's allegation that "indexing the alternate clause by type of clause" is well known, and Appellants are making it clear herein that Appellants do not agree with the Examiner's allegation that "indexing the alternate clause by type of clause" is well known. Furthermore, Appellant has provided arguments during prior prosecution traversing the rejection of claim 5, 11, 17. While the Examiner is barred from

stating new grounds for rejection during an Appeal, Appellants are not barred from making new arguments to traverse a rejection during the Appeal. Therefore, Appellants reiterate Appellants' argument that the Examiner has not provided a reference to support the Examiner's allegation that it is well known to index the alternate clause by type of clause. Accordingly, Appellants respectfully maintain that the Examiner has not satisfied the Examiner's burden of proof to establish a *prima facie* case of obviousness in relation to claims 5, 11, and 17.

Claim 20

As argued by Appellants' Brief, Luchs in view of Hoyt and Shirley in further view of Grubb do not teach or suggest: "wherein said library of alternate clauses is recorded on said medium".

In the office action rejection, the Examiner argued: "Regarding dependent claim 20, Luchs, Hoyt, Shirley, and Grubb do not explicitly disclose recording a library of alternate clauses on a medium. However, it was known and typical at the time of the art to store libraries on a computer readable medium accessible to an application associated with said libraries. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the library on a computer readable medium accessible to the current invention. This would have provided a user with easy access to the libraries".

Appellants' Brief argued that "the Examiner is not persuasive because the Examiner's argument is generic and non-specific. In particular, the Examiner has not offered any argument that relates specifically to Luchs' invention. If the Examiner is permitted to offer a generic, non-specific argument without any consideration of the specifics of Luchs' invention, then the

Examiner would be able to use such an argument with respect to *any invention* for which it is theoretically possible to use a computer readable medium. ”.

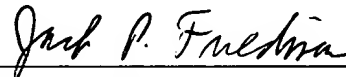
The Examiner’s Answer argues that “Appellant argues that the rejection of Claim 20 by the Examiner is "generic and non-specific." However, as explained with respect to claims 13, the argument is not persuasive”.

In response to the Examiner’s Answer, Appellants maintain reiterate that the Examiner’s argument in the office action rejection for rejecting claim 20 was generic and was not applied specifically to any aspect of the inventions of Luchs, Hoyt, Shirley, and Grubb. Therefore, Appellants contend that the Examiner has not satisfied the Examiner’s burden of proof to establish a *prima facie* case of obviousness in relation to claim 20.

SUMMARY

In summary, Appellants respectively request reversal of the rejection of claims 1-21 under 35 U.S.C. §103(a) in the office action mailed August 25, 2003.

Respectfully submitted,



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